

PATENT

(Practitioner's Dock t No. IN- 5505)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Bernd MAYER et al.

Serial No.: 09/889,647

Filed: July 19, 2001

Group Art Unit: Not assigned

Examiner: Not assigned

For: Coating Agent Comprising At Least Four Components, Method For Producing Same And Use Thereof

Assistant Commissioner of Patents
Washington, D.C. 20231

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NOV 26 2001

GROUP 3700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the following PAGES are being facsimile transmitted to the Patent and Trademark Office fax No.: (703) 872-9310 on the date shown below.

(X) Communication For Submitting the English Translation
Of The International Preliminary Examination Report
In Triplicate

03 Pages

(X) English Translation Of The International Preliminary
Examination Report

07 Pages

Total Pages

10 Pages

Date: November 14, 2001

Sandra Barry

(Typed or printed name of person signing certification)

Sandra Barry
Signature

(certificate of Facsimile Transmission [8-7])

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AT LEAST FOUR COMPONENTS,
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GROUP 3700

**COMMUNICATION FOR SUBMITTING THE ENGLISH TRANSLATION OF THE
INTERNATIONAL PRELIMINARY EXAMINATION REPORT**

Hon. Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Submitted herewith is a copy of the English Translation of the International
Preliminary Examination Report for the above-mentioned patent application.

Applicant believes that no fee is required for submitting the English Translation of the
International Preliminary Examination Report. However, if applicant has inadvertently
overlooked the need for a fee the Commissioner is hereby authorized to charge any
additional fees or credit any overpayment to Deposit Account No. 23-3425.

This form is submitted in triplicate.

Respectfully Submitted,

Michael F. Morgan
Michael F. Morgan
Registration No. 42,906

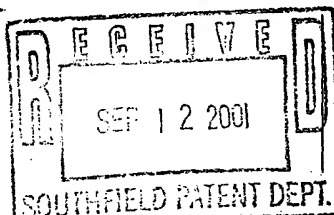
Date: November 14, 2001
BASF Corporation
28701 Telegraph Road
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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT,
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/889647	MAYER B	IN-5505
INTERNATIONAL APPLICATION NO.		

BASF CORPORATION
ANNE GERRY SABOURIN
26701 TELEGRAPH ROAD
SOUTHFIELD, MI 48034 2442

PCT/EP00/00534

I.A. FILING DATE	PRIORITY DATE
25 JAN 00	28 JAN 99

DATE MAILED: 10 SEP 2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):

- | | |
|--|---|
| <input checked="" type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Indication of Small Entity Status. |
| <input checked="" type="checkbox"/> Copy of the international application. | <input checked="" type="checkbox"/> Translation of the international application into English. |
| <input type="checkbox"/> Oath or Declaration of inventors(s). | <input type="checkbox"/> Translation of Article 19 amendments into English. |
| <input type="checkbox"/> Copy of Article 19 amendments. | <input checked="" type="checkbox"/> Other: Preliminary Amendment; Information Disclosure Statement; |
| <input checked="" type="checkbox"/> Priority Document. | |
| <input checked="" type="checkbox"/> The International Preliminary Examination Report in English and its Annexes, if any. | |
| <input type="checkbox"/> Translation of Annexes to the International Preliminary Examination Report into English. | |

2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- ☐ U.S. Basic National Fee. ☐ Copy of the international application.

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☐ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
- ☒ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

4. Additional claim fees of \$_____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

5. ☐ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.

7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the
United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22304-1450 (37 CFR 1.5)

PATENT COOPERATION TREATY

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY
EXAMINATION REPORT

(PCT Rule 72.2)

From the INTERNATIONAL BUREAU

To:

Arb: *[Signature]*
03. Sep. 2001
Fritz: _____
Fritz: _____

FITZNER, Uwe
Linterfer Str. 10
D-40878 Ratingen
ALLEMAGNE

Date of mailing (day/month/year) 23 August 2001 (23.08.01)	
Applicant's or agent's file reference PAT99818PCT	IMPORTANT NOTIFICATION
International application No. PCT/EP00/00534	International filing date (day/month/year) 25 January 2000 (25.01.00)
Applicant BASF COATINGS AG et al	

1. Transmittal of the translation to the applicant.

The International Bureau transmits herewith a copy of the English translation made by the International Bureau of the international preliminary examination report established by the International Preliminary Examining Authority.

2. Transmittal of the copy of the translation to the elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following elected Offices requiring such translation:

JP,US

The following elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

EP,BR

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report.

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer <i>[Signature]</i> ALI SOLEMAN
Facsimile No. (41-22) 740.14.36	Telephone No. (41-22) 338.83.38

4232523

Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

3

Applicant's or agent's file reference PAT99818PCT	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP00/00334	International filing date (day/month/year) 25 January 2000 (25.01.00)	Priority date (day/month/year) 28 January 1999 (28.01.99)
International Patent Classification (IPC) or national classification and IPC C09D 175/04		
Applicant BASF COATINGS AG		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of _____ sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☒ Certain defects in the international application
- VIII ☒ Certain observations on the international application

Date of submission of the demand 03 August 2000 (03.08.00)	Date of completion of this report 06 March 2001 (06.03.2001)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

Form PCT/IPEA/409 (cover sheet) (January 1994)

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP00/00534

1. Basis of the report

1. This report has been drawn on the basis of (Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 1d are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.):

- ☐ the international application as originally filed.
- ☒ the description, pages 1-61, as originally filed,
pages _____, filed with the demand,
pages _____, filed with the letter of _____,
pages _____, filed with the letter of _____.
- ☒ the claims, Nos. 1-13, as originally filed,
Nos. _____, as amended under Article 19,
Nos. _____, filed with the demand,
Nos. _____, filed with the letter of _____,
Nos. _____, filed with the letter of _____.
- ☐ the drawings, sheets/fig _____, as originally filed,
sheets/fig _____, filed with the demand,
sheets/fig _____, filed with the letter of _____,
sheets/fig _____, filed with the letter of _____.

2. The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/fig _____

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP 00/00534

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	2-13	YES
	Claims	1	NO
Inventive step (IS)	Claims		YES
	Claims	2-13	NO
Industrial applicability (IA)	Claims	1-13	YES
	Claims		NO

2. Citations and explanations

Closest prior art

D1 DE-A-196 18 446.

Novelty

Claim 1 of D1 describes a disperse acrylate copolymer (A1) that also contains particles and therefore has to be "finely divided" and "solid", a polyester resin (A2) having a hydroxyl group, a polyurethane resin (A3) containing water according to page 12, line 40 and a polyisocyanate (F1).

Consequently, the following comparison of the components can be made:

Application	D1
(I)	A2
(II)	F1
(III)	A3
(IV)	A1.

The subject matter of Claim 1 is thus no longer novel.

Form PCT/PEA/409 (Box V) (January 1994).

Received from <2489482093> at 11/14/01 9:53:41 AM [Eastern Standard Time]

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP 00/00534

Inventive step

The rest of the claims do not seem to contain any additional features which, when combined with the features of Claim 1, might lead to subject matter involving an inventive step.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/EP 00/00534

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

Since D1 was not cited and briefly acknowledged in the description, the application does not meet the requirements of PCT Rule 5.1(a)(ii).

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP 00/00534

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

- (i) The expression "substantially free" in Claim 1, part (III) is not clear in this case because it should be possible to distinguish the two components (III) and (IV) clearly from each other.
- (ii) Claims 7, 11 and 13 are not concise because they contain "in particular" features; the latter do not have a delimiting effect and are therefore superfluous.